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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,257	01/21/2004	Kia Silverbrook	WAL09US	1584
24011	7590	11/25/2008	EXAMINER	
SILVERBROOK RESEARCH PTY LTD			UHLENHAKE, JASON S	
393 DARLING STREET				
BALMAIN, 2041			ART UNIT	PAPER NUMBER
AUSTRALIA			2853	
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			11/25/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/760,257	SILVERBROOK ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	JASON S. UHLENHAKE	2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 19 August 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-7,9,11-13,17,19,31,37,38 and 40 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-7, 9, 11-13, 17, 19, 31, 37-38, 40 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1, 6, 9, 11-12, 17, 19, 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouchard et al (U.S. Pat. 6,842,186) in view of Goldstein (U.S. Pub. 2002/0069078), Gresky (U.S. Pat. 5,914,473) and Kawamura et al (U.S. Pat. 6,249,301)

#### ***Bouchard et al discloses:***

- ***regarding claims 1***, a method for operating a wallpaper printing business, the method comprising:;

- using one or more printer input devices which communicate with a processor to capture preference data regarding one or more customers preferences (Column 7, Lines 29-41)

- utilizing an on-demand printer comprising a cabinet, in which is located a media path which extends a media loading area to a print head and from the print head to a dispensing slot, to print a roll (214) of wallpaper onto a web of blank media on demand (Figures 2, 6; Column 10, Line 66 - Column 11, Line 4; Column 19, Lines 60-63)

- ***regarding claim 6***, providing the printer with a scanner for capturing data that specifies a selected pattern or other data (Column 7, Lines 30-41)

- ***regarding claim 9***, the customer can use an input device to alter how the printer prints a selected pattern (Column 6, Line 66 – Column 7, Line 7)
- ***regarding claim 37***, a print head is located in the media path and the processor accepts operator inputs from one or more input devices; using one or more input devices which communicate with the processor to capture data from an operator regarding a specification for an operators requirements (Bouchard: Column 7, Lines 29-41; Column 9, Lines 1-15); using the processor to operatively control the printer according to the data; and printing a single roll of wallpaper, on demand taking into accordance the data (Column 6, Lines 41-56)

***Bouchard does not disclose expressly the following:***

- ***regarding claim 1***, providing a display of a plurality of patterns and scanning an identifier associated with pattern selected by a customer from the display and performing printing based on the scanned identifier; charging a customer for the roll
- packaging the roll of wallpaper into a tote as the wallpaper is being dispensed into the dispensing slot

***Goldstein discloses:***

- ***regarding claim 1***, charging a customer for the roll. Goldstein discloses a system for creating custom wallpaper including a program to charge and obtain fee from customers who ordered printed wallpaper rolls (Figure 2, steps 208, 210, 212, 214), for the purpose of allowing an operator/customer to purchase created custom wallpaper (Paragraphs 0043-0046)

***Kawamura discloses:***

- ***regarding claim 1***, packaging the roll of wallpaper into a tote as the wallpaper is being dispensed into the dispensing slot (Figure 4; Abstract; Column 3, Lines 42-60), for the purpose of providing a high-quality picture at a low running cost

***Gresky discloses:***

- ***regarding claim 1***, providing a display of a plurality of patterns and scanning an identifier associated with pattern selected by a customer from the display and performing printing based on the scanned identifier (Column 2, Lines 59-67 and Column 3, Lines 31-40). Gresky discloses that information will be provided by scanning an identifier (barcode), therefore when combined with the apparatus of Bouchard, information will be provided to the apparatus in order to print the desired images, for the purpose of allowing products to be scanned quickly and efficiently (Column 3, lines 41-45)

It would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Goldstein, Kawamura and Gresky into the device of Bouchard, for the purpose of providing a high-quality picture at a low running cost; allowing an operator/customer to purchase created custom wallpaper

Claims 3-4, 7, 13, 11, 12, 17, 19, 38, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouchard et al (U.S. Pat. 6,842,186) as modified by Goldstein (U.S. Pub. 2002/0069078), Gresky (U.S. Pat. 5,914,473) and Kawamura et al (U.S. Pat. 6,249,301) as applied to claim 1 above, and further in view of Martin (U.S. Pub. 2002/0171692)

***Bouchard as modified by Goldstein, Gresky and Kawamura discloses:***

- ***regarding claim 4***, charging the customer only for the length Goldstein discloses a system for creating custom wallpaper including a program to charge and obtain fee from customers who ordered printed wallpaper rolls (Goldstein: Figure 2, steps 208, 210, 212, 214)
- ***regarding claim 3***, using the printer to cut (17) the web to the roll length (Kawamura: Figure 4; Abstract; Column 3, Lines 42-60)
- ***regarding claim 13***, loading a disposable media tote into a winding area adjacent to the dispensing slot; winding a printed roll of wallpaper onto a core inside the tote and severing the printed roll on the core from the web (Kawamura: Figure 4; Abstract; Column 3, Lines 42-60)
- ***regarding claim 38***, obtaining or attempting to obtain a fee from the franchisee (Goldstein: Figure 2, steps 208, 210, 212, 214)
- ***regarding claim 40***, on demand printer includes a processor which accepts operator inputs from one or more input devices and which control the printer; using one or more input devices which communicate with the processor to capture data from an operator regarding a specification; running the printer according to the data (Column 6, Lines 40-56; Column 7, Lines 30-42; Column 9, Lines 1-15)

***Bouchard as modified by Goldstein, Gresky and Kawamura discloses all of the claimed limitations except for the following:***

- ***regarding claim 3***, allowing the customer to select a roll length; capturing the roll length as data with a printer input device

- ***regarding claim 7***, allowing the customer to select a media type and using that media type in the printer
- ***regarding claim 13***, winding a printed roll of wallpaper onto a core
- ***regarding claim 11***, the customers requirements comprise a pattern and a configuration; the configuration being one or more parameters selected from the group comprising: roll length, a roll slitting arrangement, one or more modifications to the pattern, or a selection of media to be printed on
- ***regarding claim 12***, loading a media canister into the printer, the canister containing an unprinted web of media; and using a motor in the printer to advance the unprinted web into the path; automatically threading the media form the loading area to the dispensing slot
- ***regarding claim 17***, an operator uses the printer for a customer
- ***regarding claim 19***, selling printed rolls as they are produced to eliminate printed wallpaper inventory
- ***regarding claim 37***, printing a single roll of wallpaper, on demand taking into
- ***regarding claim 38***, providing to franchisees, an on-demand printer comprising a cabinet in which is located a media path which extends from a media loading area to a print head and from the print head to a dispensing slot; the printer having one or more printer input device which communicate with a processor to capture data regarding one or more customer requirements, the data comprising at least a customer selected pattern; providing the franchisee with a collection of patterns in a

digital storage medium that can be read by the printer; enabling the franchisee to print a roll of wallpaper onto a web of blank media on demand according to the selected pattern

- ***regarding claim 40***, printing a single roll of wallpaper on demand, according to the selected pattern and configuration; changing the pattern according to a new datum from the operator; and then printing a new roll onto the same web

***Martin discloses:***

- ***regarding claim 3***, allowing the customer to select a roll length; capturing the roll length as data with a printer input device (Martin: Paragraphs 0009-0010)
- ***regarding claim 7***, allowing the customer to select a media type and using that media type in the printer (Martin: Figures 1-2; Paragraph 0010)
- ***regarding claim 13***, winding a printed roll of wallpaper onto a core (Martin: Figure 2; Paragraph 0009; element 26 - take-up roller)
- ***regarding claim 11***, the customers requirements comprise a pattern and a configuration; the configuration being one or more parameters selected from the group comprising: roll length, a roll slitting arrangement, one or more modifications to the pattern, or a selection of media to be printed on (Paragraph 0010)
- ***regarding claim 12***, loading a media canister into the printer, the canister containing an unprinted web of media; and using a motor in the printer to advance the unprinted web into the path; automatically threading the media form the loading area to the dispensing slot (Figure 2; Paragraphs 0009-0010)

- ***regarding claim 17***, an operator uses the printer for a customer (Paragraph 0011)
  - ***regarding claim 19***, selling printed rolls as they are produced to eliminate printed wallpaper inventory (Figure 3; Paragraph 0011)
  - ***regarding claim 38***, providing to franchisees, an on-demand printer comprising a cabinet in which is located a media path which extends from a media loading area to a print head and from the print head to a dispensing slot; the printer having one or more printer input device which communicate with a processor to capture data regarding one or more customer requirements, the data comprising at least a customer selected pattern; providing the franchisee with a collection of patterns in a digital storage medium that can be read by the printer; enabling the franchisee to print a roll of wallpaper onto a web of blank media on demand according to the selected pattern (Figures 1-3; Paragraphs 0009-0011)
- ***regarding claim 40***, printing a single roll of wallpaper on demand, according to the selected pattern and configuration; changing the pattern according to a new datum from the operator; and then printing a new roll onto the same web (Paragraphs 0009-0011). Martin discloses that the length of wallpaper to be printed can be input, therefore the user will be able to choose different lengths of wallpaper and also choose different images to print on the same web as desired

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Martin into the device of Bouchard

as modified by Goldstein, for the purpose of improving wallpaper border products that are personalized to the user (Paragraph 0003)

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bouchard et al (U.S. Pat. 6,842,186) as modified by Goldstein (U.S. Pub. 2002/0069078), Gresky (U.S. Pat. 5,914,473) and Kawamura et al (U.S. Pat. 6,249,301) as applied to claim 1 above, and further in view of Fujii et al (U.S. Pat. 6,715,423) and Kwasny (U.S. Pub. 2002/01189900)

***Bouchard as modified by Goldstein, Gresky and Kawamura discloses all of the claimed limitations except for the following:***

- ***regarding claim 2***, the printer allows the customer to select a width; the printer captures the width as data with a printer input device; and the printer is used to slit the web to the width

***Fujii et al*** teaches calculating an amount of wallpaper required by the customer based on room dimensions such as width supplied by customers (Figures 6-7, 9). However, Fujii et al does not disclose cutting/slitting a web. ***Kwasny*** teaches a slitting/cutting mechanism (16) for slitting a web.

It would have been obvious to one of ordinary skill in the art to incorporate the teachings of Fujii and Kwasny into the device of Bouchard as modified by Goldstein, Gresky and Kawamura, for the purpose of improving the efficiency of cutting a web into multiple narrow sheets

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bouchard et al (U.S. Pat. 6,842,186) as modified by Goldstein (U.S. Pub. 2002/0069078), Gresky (U.S. Pat. 5,914,473) and Kawamura et al (U.S. Pat. 6,249,301) as applied to claim 1 above, and further in view of Stoffel et al (U.S. Pat. 6,412,990)

***Bouchard as modified by Goldstein, Gresky and Kawamura disclose all of the claimed limitations except for the following:***

- ***regarding claim 5***, acquiring data from a touch-screen display which is also adapted to display the pattern

***Stoffel discloses:***

- ***regarding claim 5***, acquiring data from a touch-screen display which is also adapted to display the pattern (42 of Figure 15; Column 8, Lines 55-60)

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Stoffel into the device of Bouchard as modified by Goldstein, Gresky and Kawamura, for the purpose of allowing an operator/customer to custom print images by simply touching the viewing screen (Column 8, Lines 55-60)

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bouchard et al (U.S. Pat. 6,842,186) as modified by Goldstein (U.S. Pub. 2002/0069078), Gresky (U.S. Pat. 5,914,473) and Kawamura et al (U.S. Pat. 6,249,301) as applied to claim 1 above, and further in view of and Zander (U.S. Pat. 5,200,777)

***Bouchard as modified by Goldstein, Gresky and Kawamura disclose:***

- ***regarding claim 31***, a case in which a roll of blank media may be deployed; and the case having internally and adjacent to the slot, a pair of rollers (23), at least one of the rollers being a driven roller which is supported at each end by the case for rotation by an external motor (Kawamura: Figure 4; Column 4, Lines 1-7)

***Bouchard as modified by Goldstein, Gresky and Kawamura disclose all of the claimed limitations except for the following:***

- ***regarding claim 31***, the case having two halves, hinged together, an area between the two halves, when closed, defining a media supply slot

***Zander discloses:***

- ***regarding claim 31***, the case having two halves, hinged together (Figure 2), an area between the two halves, when closed, defining a media supply slot (47); (Figures 2, 8-9)

At the time the invention was made it would have been obvious to a person of ordinary skill in the art to incorporate the teaching of Zander into the device of Bouchard as modified by Goldstein, Gresky and Kawamura, for the purpose of providing a high-quality picture at a low running cost and providing easily accessible media supply container

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-7, 9, 11-13, 17, 19, 31, 37-38, 40 have been considered but are moot in view of the new ground(s) of rejection. Please see the above rejections based on Bouchard et al (U.S. Pat. 6,842,186) in view of

Goldstein (U.S. Pub. 2002/0069078), Gresky (U.S. Pat. 5,914,473) and Kawamura et al (U.S. Pat. 6,249,301). This combination discloses a scanning an identifier selected by a customer form the display of varying patterns.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON S. UHLENHAKE whose telephone number is (571)272-5916. The examiner can normally be reached on Monday-Friday 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JASON S UHLENHAKE/  
Examiner, Art Unit 2853  
November 19, 2008

/Julian D. Huffman/  
Primary Examiner, Art Unit 2853